

REMARKS

The Office Action dated October 3, 2007, has been received and carefully noted. The above amendments to the claims, and the following remarks, are submitted as a full and complete response thereto.

Claims 1-22 and 98 are currently pending in the application, of which claims 1 and 98 are independent claims. Claims 1 and 98 have been amended to more particularly point out and distinctly claim the subject matter of the invention. No new matter has been added. Claims 1-22 and 98 are respectfully submitted for consideration.

Claims 1, 5-6, 8-10, 12-13, 16, 18-20, 22, and 98 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,721,306 of Farris et al. ("Farris") in view of U.S. Patent No. 6,014,377 of Gillespie ("Gillespie"). With respect to independent claim 1 and 98, the Office Action took the position that Farris discloses all of the features of the claims except the features, "network element to determine whether said UE is a subscriber of the first network and to make a query to a HLR in a second network when UE is not a subscriber of the first network." The Office Action cited Gillespie to remedy these deficiencies of Farris. Applicant respectfully traverses this rejection.

Claim 1, upon which claims 2-22 depend, is directed to a network element including a first interface configured to communicate with a first internet protocol based network using an internet protocol to receive signals from and send signals to the first network, the first internet protocol based network being a private computer based network including wireless capabilities. The first interface is configured such that

internet protocol traffic intended for a wireless user equipment within the first internet protocol based network from another user equipment within the first network can occur without any signaling occurring externally of the first network. The network element also includes a second interface configured to communicate with a second external packet data network via an internet protocol based connection to receive signals from and send signals to the second packet data network, the wireless user equipment being usable with the second network. The network element is located between the first internet protocol based network and the second external packet data network. The network element is configured to determine whether a particular wireless user equipment is a subscriber of the first network and when the particular wireless user equipment is not a subscriber of the first network to make a query to a home location register in the second network.

Claim 98 is directed to a network element including first interface means for communicating with a first internet protocol based network using an internet protocol to receive signals from and send signals to the first network. The first internet protocol based network is a private computer based network including wireless capabilities. The interface is configured such that internet protocol traffic intended for a wireless user equipment within the first internet protocol based network from another user equipment within the first network can occur without any signaling occurring externally of the first network. The network element also includes second interface means for communicating with a second external packet data network via an internet protocol based connection to receive signals from and send signals to the second packet data network, the wireless user equipment being usable with the second network. The network element is located

between the first internet protocol based network and the second external packet data network. The network element includes means for determining whether a particular wireless user equipment is a subscriber of the first network and means for making a query to a home location register in the second network when the particular wireless user equipment is not a subscriber of the first network.

Applicant respectfully submits that the combination of Farris and Gillespie fails to disclose or suggest all of the elements of any of the presently pending claims.

Gillespie generally relates to a system and method for an integrated wireline/wireless service using private branch exchange lines. Thus, Gillespie discusses a technique for integrating a private branch exchange (PBX) network with a wireless network and a wireline network. With reference to, for example, Figure 2 of Gillespie, a process whereby a call may be routed to the wireless network instead of being routed to the PBX network is described.

Most importantly however, there is no suggestion in Gillespie that any piece of equipment may subscribe in more than one network. Moreover, since two of the networks, the wireline network and the PBX network, are wired networks, there is logically no reason why any user equipment would need to subscribe in the sense that subscription is required in a wireless network.

Moreover, based on the description of Gillespie, it is clear that none of the three user equipment identified in these networks (the mobile telephone 42, the wireline networks telephone 38 and the PBX network telephone 20) may move or be subscribed in any of the other networks.

Consequently, Gillespie fails to teach the feature “said network element is configured to determine whether a particular wireless user equipment is a subscriber of the first network and when said particular wireless user equipment is not a subscriber of the first network to make a query to a home location register in said second network” as recited in claim 1 (features that the Office Action admitted Farris fails to teach).

Consequently, it is submitted that irrespective of whether it would have been obvious to combine the teachings of the cited references, the present invention as recited in, for example, claim 1, cannot be taught even in the combination of references.

The Office Action cited parts of the abstract of Gillespie to teach the features of the claim. In particular, the Office Action referred to querying a home location register of the wireless network if mobile registration status data indicates that the subscriber is wireless registered. In this portion of Gillespie there is only one network: the wireless network in which the mobile station is registered. As recited in claim 1, “said network element is configured to determine whether a particular wireless user equipment is a subscriber of the first network,” can only be aligned with a feature of Gillespie wherein a determination is made as to whether the user equipment is a subscriber of the wireless network. The wireless network is the first network in Gillespie.

Consequently, the second part of this feature of claim 1, “when said particular wireless user equipment is not a subscriber of the first network to make a query to a home location register in said second network,” can only be taught by a home location register existing in a second network. This second network by definition must be different from the “first network,” which, as established above, is the wireless network in Gillespie

under the Office Action's implicit interpretation. There is no "second network" containing an HLR. Consequently, this feature clearly cannot be taught in Gillespie.

Applicant notes for completeness that the wireline network and the private network of Gillespie do not contain HLRs. Thus, for this additional reasons, Gillespie cannot remedy the deficiencies of Farris, and the combination of Farris and Gillespie cannot disclose or suggest all of the elements of claim 1.

Thus, claim 1 is novel over both of Farris and Gillespie, even in combination. Moreover, neither Farris nor Gillespie identifies or provides any motivation for an arbitrary change to their construction, which would lead to the present invention. Consequently, it is clear that the presently recited invention presented in claim 1 is non-obvious over the combined disclosures of Farris and Gillespie.

The Office Action took the position that motivation to combine Farris and Gillespie would have arise from a motivation "to enable service integration and to facilitate roaming of the UE." The Office Action, however, provides no rational explanation as to how this alleged motivation is derived, and it does not appear to have come from the references themselves or more generally from the knowledge of one of ordinary skill in the art at the time the invention was made. Thus, it is respectfully submitted that the Office Action has failed to establish a *prima facie* case for obviousness of the combination, because the Office Action has merely stated a rationale that appears to be derived solely from the disclosure of the present application. Accordingly, for this additional reason, the rejection of claim 1 should be withdrawn.

Independent claim 98 has its own scope. Claim 98, however, recites at least some features similar to those discussed above with respect to claim 1, and was not separately rejected. Thus, the deficiencies in the rejection of claim 1 are also deficiencies with respect to claim 98, and correspondingly mandate the withdrawal of the rejection of claim 98. Timely withdrawal of the rejection of claim 98 is respectfully requested.

Claims 5-6, 8-10, 12-13, 16, 18-20, and 22 depend from and further limit claim 1. Thus, each of claims 5-6, 8-10, 12-13, 16, 18-20, and 22 recites subject matter that is neither disclosed nor suggested in the hypothetical combination of Farris and Gillespie. It is, therefore, respectfully requested that the rejection of claims 5-6, 8-10, 12-13, 16, 18-20, and 22 be withdrawn.

Claims 2-4, 7, 11, 14-15, and 17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Farris in view of Gillespie and further in view of U.S. Patent No. 7,042,855 of Gilchrist et al. ("Gilchrist"). Applicant respectfully traverses this rejection.

Claim 11 is listed as rejected under this combination, but no explanation of the rejection of claim 11 is provided. Accordingly, the rejection of claim 11 ought to be withdrawn.

Additionally, Gilchrist is not proper prior art, because it was filed (and published) after the priority date of the present application. Gilchrist was filed February 25, 2000, and the present application is entitled to the priority at least of June 4, 1999. Applicant notes for the Examiner's convenience that WO 99/50974, is an earlier publication (than Gilchrist) that seems to be related to Gilchrist. Because the rejection cannot stand without Gilchrist, the rejection based on Gilchrist should be withdrawn.

Claim 21 was rejected under 35 U.S.C. 103(a) as being unpatentable over Farris in view of U.S. Patent No. 6,560,443 of Vaisanen et al. ("Vaisanen"). Applicant respectfully traverses this rejection.

Vaisanen is a U.S. patent that was subject to an obligation of assignment to the same entity as the present application was at the time of the invention, and is only available as prior art, if at all, under 35 U.S.C. 102(e). Accordingly, Vaisanen cannot be used to establish obviousness of any of the presently pending claims, because such usage is barred by 35 U.S.C. 103(c).

Specifically, Vaisanen was subject to an obligation of assignment to Nokia Corporation, as can be seen from line 73 of the cover page of Vaisanen. Likewise, the present application was subject to an obligation of assignment to Nokia Corporation, as can be seen from assignment document recorded on April 10, 2002, at Reel 013038, Frame 0765.

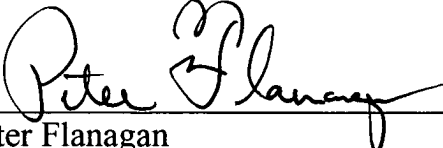
Furthermore, Vaisanen was published May 6, 2003, which is after the U.S. filing date of the present application (April 10, 2002). Thus, 35 U.S.C. 103(c) bars Vaisanen from being used to show obviousness of the present application's claims. Since the rejection cannot stand without Vaisanen, it is respectfully requested that the rejection of Vaisanen be withdrawn.

For the reasons set forth above, it is respectfully submitted that each of claims 1-22 and 98 recites subject matter that is neither disclosed nor suggested in the cited art. It is, therefore, respectfully requested that all of claims 1-22 and 98 be allowed, and that this application be passed to issuance.

If, for any reason, the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, Applicant's undersigned representative at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,


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